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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,401	02/12/2002	Ian Stuart Pardoc	S1011/20127	7651

7590 03/19/2004

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EXAMINER

PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,401

Applicant(s)

PARDOE, IAN STUART

Examiner

Patricia A Patten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-33 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 20-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/12/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 13-33 are pending in the application.

Claims 13-14, 20-33 were withdrawn from the merits in the Office Action dated 8/7/03.

Applicant's statements regarding the claim numbering was considered. The claim numbering that appears in the most recent amendment is sufficient. The dependency of non-elected claims do not need to be corrected since they are withdrawn, and may be amended at a later date in the event of a rejoinder of claims.

Claims 15-19 were examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

### ***Claim Rejections - 35 USC § 102***

Claims 15-17 and 19 remain rejected under 35 U.S.C. 102(b) as being anticipated by Briand (US 5,508,033) for the reasons set forth in the previous Office Action as well as *infra*.

Applicant's arguments were fully considered, but not found persuasive.

Applicant argues that claims 15 and 16 recite 'for treating viruses' and that claim 19 states "...for administration in the treatment of the Herpes family" (p.9-Arguments). Applicants contend that because Briand does not disclose the use of this composition for treatment of Herpes or viruses, that this rejection should be removed.

In the Instant case, the intended uses of claims 15-17 and 19 have been fully considered to ascertain whether they hold any patentable weight. It has been deemed that the intended uses of these claims do not materially change the composition and therefore hold no patentable weight since these are composition claims. Thus, this argument is not found convincing. Applicant is asked to review *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). "When the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated" (MPEP 2100 pp. 2113).

### ***Claim Rejections - 35 USC § 103***

Claim 15-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Briand (US 5,508,033) for the reasons set forth in the previous Office Action as well as *infra*.

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Here, Applicant has presented arguments analogous to the arguments presented supra under the 35 USC 102 rejection; that because Briand does not teach the recited intended uses in these claims, that Briand does not obviate the claimed invention.

To reiterate, the intended use of a composition only holds patentable weight in-so far as it actually affects the characteristics of the composition. In the Instant case, the intended uses 'for treating viruses' or 'for administration in the treatment of the Herpes family' does not change any characteristic of the composition and therefore does not hold any patentable weight.

These claims, therefore, remain rejected for the reasons set forth on the record.

No claims are allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A Patten whose telephone number is (571) 272-0968. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0968. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patricia A Patten  
Examiner  
Art Unit 1654

A handwritten signature in cursive script, appearing to read "Patricia A. Patten".

**PATRICIA PATTEN  
PATENT EXAMINER**

A handwritten signature in cursive script, appearing to read "Christopher R. Tate".

**CHRISTOPHER R. TATE  
PRIMARY EXAMINER**